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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,646	07/29/2003	David William James Holmes	101948001US2	8268

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EXAMINER

WEST, LEWIS G

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/630,646	Applicant(s) JAMES HOLMES ET AL.	
	Examiner Lewis G. West	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-43 and 45-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-43, 45-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 35 of U.S. Patent No. 6,636,749 in view of Pan (US 6,304,674) Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 35 of the patent claim means for carrying out the steps of the method of claim 37 of the application, the only difference being coupling by way of a cigarette lighter or vehicle accessory outlet. Pan discloses an in vehicle short-range communications device that uses a cigarette lighter or vehicle accessory outlet to power a mobile device. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a cigarette lighter as a power source in a vehicle, as it provides a direct connection for power from the battery within the cabin of most vehicles and is usually placed in a location in the dash that makes it easily useable with a communications device in use by a driver or front seat passenger.

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Claims 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,636,749 in view of Pan (US). Claim 38 of the application further provides the limitation of Bluetooth, as does claim 36 of the patent. So it is obvious for the same reasoning applied to the base claims.

Claims 39 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 35 of U.S. Patent No. 6,636,749 in view of Pan (US). Although not expressly stated, it is inherent that the audio must be translated to and from a wireless protocol in order to be transmitted and received via the wireless protocol. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to for the same reasoning applied to the base claim.

Claims 40 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,636,749 in view of Pan (US). A “cellular phone” as opposed to a “wireless phone”, in combination with the limitations of the parent claims, is an obvious variation, as all cellular phones are wireless, and a large number of wireless phones in use today are cellular. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a cellular phone as a wireless phone, as cellular phones have widespread use and there is existing customer demand for cellular phones.

Claims 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,636,749 in view of Pan (US 6,304,674). The patent claims a wireless short-range communications device in a vehicle but does not expressly disclose a hands-free car kit. Pan discloses a

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hands-free kit. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a hands-free car kit as an application of a short range communications in a vehicle that, in order to allow a user to use both hands and provide less of a distraction from driving.

Claims 42 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,636,749 in view of Pan (US 6,304,674). Claim 38 of the application further provides the limitation of exchanging signals using Bluetooth, as does claim 36 of the patent. So it is obvious for the same reasoning applied to the base claims.

Claims 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,636,749. Although the conflicting claims are not identical, they are not patentably distinct from each other, the difference being that claim 45 of the application broadly claims "coupling" of the wireless protocol device and the wireless device and claim 4 of the patent claims the exchange of communications which encompasses a two way flow of information between the devices, whereas the broader coupling only encompasses a signaling connection which is not necessarily a two-way exchange. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to "couple" the wireless protocol device to the wireless device, as this is broader and would be covered under the scope of the parent claim.

Claims 46 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,636,749.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth with respect to the parent claims. Both claim 46 and claim 5 add the limitations of Bluetooth.

Claims 47 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,636,749.

Although the conflicting claims are not identical, they are not patentably distinct from each other, a “cellular phone” as opposed to a “wireless phone”, in combination with the limitations of the parent claims, is an obvious variation, as all cellular phones are wireless, and a large number of wireless phones in use today are cellular. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a cellular phone as a wireless phone, as cellular phones have widespread use and there is existing customer demand for cellular phones.

Claims 48 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,636,749.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth with respect to the parent claims. Both claim 46 and 14 provide the limitation of a hands-free car kit.

Claims 51 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,636,749.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth with respect to the parent claims. Both claims 51 and 14 add the limitation of a cigarette lighter as a vehicle adapter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. IEEE 802.11 is indefinite, as there are multiple versions of the standard which have different means for different applications, also the patent may not cover future versions of the standard which do not yet exist.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43, 45, 47, 48, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Pan (US 6,304,764).

Regarding claim 43, Pan discloses a method for manufacturing a connection device, comprising: integrating a wireless protocol module into a charge cord, wherein

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the charge cord is adapted to deliver electrical power to a wireless device from a vehicle power supply; and at least partially enclosing the wireless protocol module in a housing.

(Figure 4a, 4b; column 6 lines 5-37)

Regarding claim 45, Pan discloses an apparatus for coupling a mobile device to a power supply and a wireless protocol enabled device, comprising: a charge cord having a first end and a second end, the charge cord for providing power from the power supply to the mobile device; a power adapter located at the first end of the charge cord, the power adapter for coupling the power supply to the charge cord; a connector coupled to the second end of the charge cord, the connector for coupling the charge cord to the mobile device; and a wireless protocol module coupled to the charge cord, the wireless protocol module for wirelessly coupling the mobile device to the wireless protocol enabled device; wherein the charge cord also provides power to the wireless protocol module. (Figure 4a, 4b; column 6 lines 5-37)

Regarding claim 47, Pan discloses the apparatus of claim 86, wherein the mobile device is a cellular telephone. (Figure 4a, 4b; column 6 lines 5-37)

Regarding claim 48, the apparatus of claim 86, wherein the wireless protocol enabled device is a vehicle hands-free kit capable of communicating via the wireless protocol. (Figure 4a, 4b; column 6 lines 5-37)

Regarding claim 50, Pan discloses that the apparatus of claim 86, wherein the charge cord conveys at least one of data and voice from the connector coupled with the mobile device to the wireless protocol module. (Figure 4a, 4b; column 6 lines 5-37)

Regarding claim 51, Pan discloses the apparatus of claim 86, wherein the power adapter is a vehicle cigarette lighter adapter. (Figure 4a, 4b; column 6 lines 5-37)

Claims 43, 47, 48 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinzalow et al (US 6,052,603).

Regarding claim 45, Kinzalow discloses an apparatus for coupling a mobile device (612) to a power supply (642) and a wireless protocol enabled device (616), comprising: a charge cord having a first end and a second end, the charge cord for providing power from the power supply to the mobile device; a power adapter (656) located at the first end of the charge cord, the power adapter for coupling the power supply to the charge cord (Col. 4 lines 33-42); a connector coupled to the second end of the charge cord, the connector for coupling the charge cord to the mobile device (Col. 4 lines 33-42); and a wireless protocol module (610) coupled to the charge cord; the wireless protocol module for wirelessly coupling the mobile device to the wireless protocol enabled device (Col. 3 lines 42-63); wherein the charge cord also provides power to the wireless protocol module. (Col. 4 lines 33-42)

Regarding claim 47, Kinzalow discloses the apparatus of claim 45, wherein the mobile device is a cellular phone. (Col. 3 lines 42-45)

Regarding claim 48, Kinzalow discloses the apparatus of claim 45, wherein the wireless protocol enabled device is a hands-free car kit capable of communicating via the wireless protocol. (Col. 3 lines 42-45)

Regarding claim 51, Kinzalow discloses the apparatus of claim 45, wherein the power adapter is a cigarette lighter adapter. (Col. 4 lines 33-42)

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan (US 6,304,764) in view of Larsson et al (US 6,697,638).

Regarding claim 46, Pan discloses the apparatus of claim 45 wherein the wireless protocol is a radio frequency protocol, but does not expressly disclose Bluetooth, IEEE 802.11 or HomeRF. Larsson discloses a short-range communications system between a portable device and a car which uses the Bluetooth protocol for communications. (Larsson, Col. 2 lines 37-49) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use Bluetooth, Bluetooth being a well-known, low-power short range communications protocol which is becoming an industry wide standard and would allow for interoperability with many devices.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan (US 6,304,764) in view of Palermo et al (US 5,771,438).

Regarding claim 49, Pan discloses the apparatus of claim 45, but does not disclose the use of a headset. Palermo discloses a short-range RF communications system wherein the wireless protocol device is a headset capable of communicating via a wireless protocol. (Col. 2 line 58-Col. 3 line 13) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a headset, suggestion lying in at least Palermo that any number of configurations are useful in portable devices and they may be interchangeably configured as a handset or headset, and motivation being that

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headsets are well known as a useful way to configure a portable communications device as it allows the user to carry the device without using the hands and holds the device in proximity to the ears so the user does not have to move the device in order to make it useful for communications.

Conclusion

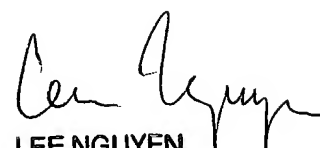
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 703-308-9298. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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